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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,713	01/16/2004	Marcia Grossman Nozik	6881-0001-1	3259

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EXAMINER

ROANE, AARON F

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 10/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/759,713

Applicant(s)

NOZIK ET AL.

Examiner

Aaron Roane

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Edwards et al. (USPN 6,440,159 B1).

Regarding claim 1, Edwards et al. disclose a sling holder (10) for holding an object for an extended period of time against the skin, said sling holder comprising: a strap (comprising 20, 22, 24 and 32) having a first end (20) and an opposing second end (22); a fastener (64) for coupling said first end to said second end; and at least one pocket attachable (see element 16 in figures 1, 3 and 4) to said strap, see col. 4-10 and figures 1-16.

Regarding claim 2, Edwards et al. further disclose a contoured section of varying width over a portion of a length of said strap, see figures 1-16.

Regarding claim 3, Edwards et al. further disclose the fastener is selectively fastenable to allow a length of said sling holder to be adjusted, see col. 4-10 and figures 1-16.

Regarding claim 4, Edwards et al. further disclose the fastener (64) is hook (65) and loop (66) fastening material, see col. 8, lines 28-44.

Regarding claim 5, Edwards et al. further disclose the strap is fabricated from a material selected from the group of materials consisting of elastic material, non-elastic material, and combinations of the foregoing materials, see col. 5, lines 32-49.

Regarding claim 6, Edwards et al. further disclose padding (65) disposed on said strap.

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Regarding claim 7, Edwards et al. further disclose the pocket is removably attachable to said strap, see element 16 in figures 1, 3 and 4 and see col. 4-10 and figures 1-16.

Regarding claim 8, Edwards et al. further disclose the pocket has an inwardly facing surface to be held against the skin of a user upon assembly of said sling holder on a body part, see col. 4-10 and figures 1-16.

Regarding claims 9 and 10, Edwards et al. further disclose that the inwardly facing surface is fabricated from a thermally conducting material, see col. 4, line 41 through col. 5, line 20. Additionally, the inwardly facing surface is fabricated from a thermally insulating material (the material comprising strips 68-70. Alternatively, all of the materials on the inwardly facing surface have finite non zero thermal conductance (as well as thermal or heat capacity) and therefore can be considered in the broad sense both thermally conducting and insulating.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 and 12-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverberg (USPN 5,823,984) in view of Allen (USPN 5,507,794).

Regarding claim 1, Silverberg discloses a sling holder (10) for holding an object for an extended period of time against the skin, said sling holder comprising: a strap (12); having a first end and an opposing second end; a fastener (14) for coupling said first end to said second end; and at least one pocket attachable (20) to said strap, see col. 1-4 and figures 1-7, particularly figures 2, 5 and 6. Silverberg fails to disclose a single fastener positioned completely within the perimeter of said strap. It is extremely well known in the art to provide a thermal pad/strap/wrap with various alternate fastening means. It should be noted that Silverberg discloses that the hook-type fasteners (14) work in combination with the loop-type surface of adjoining straps (panels 12). Allen discloses a thermal strap/device (10) and teaches an alternate means of fastening by providing the device with a single hook-type fastener positioned completely within the perimeter of the strap (10) that fastenably couples to the loop-like material on the other end and side of the strap in order to secure the strap/device about the user. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Silverberg, as is well known in the art and taught by Allen, to use a single hook-type fastener positioned completely within the perimeter of the strap as an alternate fastening means in order to secure the strap to a user.

Regarding claim 2, Silverberg further discloses a contoured section of varying width over a portion of a length of said strap, see figure 6.

Regarding claim 3, Silverberg further discloses the fastener is selectively fastenable to allow a length of said sling holder to be adjusted, see col. 1-4 and figures 1-7.

Regarding claim 4, Silverberg further discloses the fastener (14) is hook-and-loop fastening material, see col. 3.

Regarding claim 5, Silverberg further discloses the strap is fabricated from a material selected from the group of materials consisting of elastic material, non-elastic material, and combinations of the foregoing materials, see col. 3, lines 5-18.

Regarding claim 6, Silverberg further discloses padding (34) disposed on at least one of said first strap, said second strap, and said third strap, see col. 3, lines 5-18 and figure 4.

Regarding claim 7, Silverberg further discloses the pocket (20) is removably attachable to the strap, see col. 3, lines 29-52 and figure 4.

Regarding claim 8, Silverberg further discloses the pocket has an inwardly facing surface to be held against the skin of a user upon assembly of said sling holder on a body part, see figure 4.

Regarding claims 9 and 10, Silverberg further discloses the claimed invention. The material on the inwardly facing surface of the pocket/pouch (20) have finite non zero thermal conductance (as well as thermal or heat capacity) and therefore can be considered in the broad sense both thermally conducting and insulating.

Regarding claim 12, Silverberg further discloses a plurality of pockets to be attachable to said strap, see col. 4, lines 21-25 and figures 4 and 7.

Regarding claim 13, Silverberg further discloses a strap includes at least one extension (another of 12) member interposed between ends of said strap for varying the length of said strap, see figures 5 and 6.

Regarding claims 14 and 15, Silverberg further discloses at least one extension member comprises a temporary hook-loop type fastener (14) mounted on interfacially engaging portions of the strap, see col. 3, lines 18-29.

Regarding claim 16, Silverberg discloses a sling holder (10) for holding an object against the skin, said sling holder comprising: a first strap (first of 12); a second strap (second of 12) for adjusting a length of said sling holder, said second strap being attachable at a first end thereof to said first strap; a fastener (14) for coupling a second end of said second

strap to said first strap; and at least one pocket (20) attachable to at least one of said first strap and said second strap, see col. 1-4 and figures 1-7, particularly figures 2, 5 and 6.

Regarding claim 17, Silverberg further discloses a third strap (third of 12) interposable between said first strap and said second strap for further adjusting said length of said sling holder, see col. 1-4 and figures 1-7, particularly figures 2, 5 and 6.

Regarding claims 18 and 19, Silverberg further discloses said third strap is removably coupled to each of said first strap and said second strap using a hook-and-loop material (14). Additionally, Silverberg discloses the fastener (14) for coupling said first strap to said second strap at opposing ends thereof is a hook-and-loop material, see col. 3.

Regarding claim 20, Silverberg further discloses at least one of said first strap, said second strap and said third strap comprises a contoured section of varying width over a portion of a length thereof that facilitates the positioning of said strap on a body portion, see figure 6.

Regarding claim 21, Silverberg further discloses padding (34) disposed on at least one of said first strap, said second strap, and said third strap, see col. 3, lines 5-18 and figure 4.

Regarding claim 22, Silverberg further discloses the pocket (20) is removably attachable to at least one of said first strap and said second strap using a hook-and-loop fastening material, see col. 3, lines 29-52 and figure 4.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Silverberg (USPN 5,823,984) in view of Allen (USPN 5,507,794) as applied to claim 1 above, and further in view of Noppel et al. (USPN 5,069,208).

Regarding claim 11, Silverberg in view of Allen disclose the claimed invention except for a temperature indicator on at least one of said strap and said pocket. Noppel et al. disclose a thermal bag/pack containing a heat exchange agent and teach the providing the bag/pack with “a film of a sensitive material capable of indicating whether the temperature of transformation has been reached”, see col. 4, lines 60-64. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Silverberg in view of Allen, as taught by Noppel et al., to provide at least one of the strap or pocket with “a film of a sensitive material capable of indicating whether the temperature of transformation has been reached.”

Response to Arguments

Applicant's arguments filed 8/22/2005 have been fully considered but they are not persuasive.

Regarding Applicant's arguments/remarks refuting the 102(e) rejections using the Edwards et al. patent. Applicant's entire argument rests on two points: 1) Edwards et al. supposedly do not disclose a single fastener (see 3rd paragraph on page 5) and 2) the strap of Edwards et al. "has no pocket at all" (see 4th paragraph on page 5).

First, claim 1 uses the transitional phrase "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps, see MPEP 2111.0. If Applicant wishes to preclude the examiner from applying the Edwards et al. patent as a 102(e) reference, the examiner suggests Applicant use the transitional phrase "consisting" and/or add further limitations to accomplish this purpose. Secondly, Edwards et al. disclose a strap that has, albeit a selectively removable pocket and therefore the examiner disagrees with Applicant on this issue.

Regarding the arguments/remarks directed to the Silverberg patent, the arguments/remarks are moot due to a new ground on rejection.

This action is made FINAL.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 7AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.R. *A.R.*
October 5, 2005

Roy D. Gibson
ROY D. GIBSON
PRIMARY EXAMINER